

REMARKS

The present amendment is in response to the Office Action dated November 29, 2005. Claims 1-16 and 60-65 are now present in this case. Claims 1 and 65 are amended. Claim 58 is canceled.

Claims 58 and 65 stand rejected under 35 U.S.C. § 112 as indefinite. Please cancel claim 58 without prejudice. Claim 65 is amended to more clearly recite the invention. Support for the change to claim 65 may be found on page 24 of the application as originally filed. No new matter is introduced.

Claims 1, 5, 6, 8, and 64 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Chambers and Schreiber and further combined with Engels et al. The applicants respectfully traverse this rejection and request reconsideration. In the prior response, filed September 6, 2005, the applicants noted that the combination suggested in the Office Action was not possible due to the significantly different technologies described in the references that render them incapable of combination.

The present Office Action responds to the argument regarding the impermissible combination of references by stating, at page 18, that the combination of references are "based on the system disclosed in the Chambers reference and teachings found in both the Schreiber and Engels reference. The Office Action further states that Schreiber is cited only for disclosing transmission between one and 10 miles while "the Engels reference is used merely as a teaching of non line of sight internally deployed antennas. Therefore, it is the disclosed use of a non line of sight internally deployed antenna of Engels that is combined with the system and method of Chambers, not the entire system." (See Office Action, page 18.) There are a number of fatal flaws with this line of reasoning.

First, the claimed invention must be considered as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. (See M.P.E.P. § 2141.02I.) In the present case, the Examiner has clearly cited references that do not

teach or suggest the invention, but only allude to certain elements within the claims. For example, with respect to claim 1, the Examiner has cited U.S. Patent No. 5,867,485 to Chambers as disclosing a communication network operating in a frequency range less than 10 GHz. The Office Action acknowledges that Chambers does not disclose base stations having a coverage area between one and ten miles, nor does Chambers disclose consumer premises equipment having an antenna deployed internally within the premise where the CPE is located. (See Office Action, page 8.) To overcome these shortcomings, the Examiner has impermissibly combined references that, as a whole, do not suggest the claimed invention. That is, U.S. Patent No. 5,425,050 to Schreiber is cited "merely as a teaching of using a base station radius that is between one and ten miles." (See Office Action, page 18.) As noted in the previous response, Schreiber is not even a two-way communication system, but discloses a one-way television transmitter system that is incapable of operation in the manner suggested in the Office Action. Schreiber does not suggest a two-way communication system with a range between one and ten miles. Similarly, the Office Action states that "the Engels reference is used merely as a teaching of a non line of sight internally deployed antennas." (See Office Action, page 18.) The Examiner has ignored the teaching of the claims as a whole and has taken a piecemeal approach in finding references that are alleged to disclose individual elements.

A second fatal flaw to the logic presented in the present Office Action is that the proposed modification renders the prior art unsatisfactory for its intended purpose. (See M.P.E.P. § 2143.01V.) "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01V. In the present case, the Chambers reference is directed to a short-range communication network. Indeed, the title "Low Power Microcellular Wireless Drop Interactive Network" is an indication of its intended purpose as a short-range communication system (emphasis added). In contrast, the Examiner proposes to modify the short-range two-way communication system of Chambers with a long-range one-way television transmitter system of Schreiber. The two references are incompatible, intended for completely different purposes, and are not capable of modification in the manner

suggested by the Examiner. Even if Schreiber were relevant to a two-way communication system, the addition of the high-powered components in Schreiber renders the low power microcellular system of Chambers unsatisfactory for its intended purpose. Therefore, in accordance with M.P.E.P. § 21430.01V, there is no suggestion to combine Chambers and Schreiber.

Furthermore, the Examiner has cited Engels merely as disclosing the use of an internally deployed antenna. However, it should be noted that Engels does not disclose any antenna system. Indeed, the word “antenna” does not ever appear in the Engels reference. Rather, Engels discloses a simulation process used to develop an integrated circuit for use in an indoor communication network. There is no disclosure and no support for any antenna system in Engels. Furthermore, even if *arguendo* Engels did disclose an antenna, it is clearly intended solely for use in an indoor communication system. Any antenna system that may be inherently disclosed in Engels does not suggest an antenna used in a CPE capable of communication with a base station over a range of one to ten miles, as recited in claim 1. Therefore, the modification of Chambers to include Schreiber and Engels, as proposed by the Examiner, renders Chambers unsatisfactory for the intended purpose. Such an unsatisfactory modification precludes the combination of references suggested by the Examiner.

A third fatal flaw to the logic recited in the present Office Action lies in the combination of references. It is a well settled rule that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. (See M.P.E.P. § 2142.) The applicants note that the disparate references provide no suggestion for the combination cited in the Office Action. Under the M.P.E.P. standards, any alleged motivation to combine or modify references must be objectively verifiable. The M.P.E.P. recognizes the pitfalls associated with the tendency to subconsciously use impermissible “hindsight” when an examiner attempts to establish such a rationale. The M.P.E.P. has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that “under 35 U.S.C. § 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just

before it was made. Secondly, in view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (See M.P.E.P. § 2142, emphasis added.)

The applicants respectfully point out that nowhere has the Office Action pointed to any objectively verifiable motivation to modify and/or combine the teachings of Chambers, Schreiber and/or Engels to produce the claimed invention beyond the bare assertion that Schreiber is cited "merely as a teaching of using a base station radius that is between one and ten miles." (See Office Action, page 18.) A similar bare assertion is made with respect to Engels. As has been discussed in detail above, Chambers and Schreiber are directed to disparate wireless technologies. Chambers is a low power microcellular two-way communication system while Schreiber discloses a higher power one-way television transmitter system. Engels is cited for disclosing an internally deployed antenna even though it clearly never discloses any antenna at all. None of the references provide a suggestion for the combination recited in the Office Action. Accordingly, the applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine or modify. In the absence of objectively verifiable motivation to modify and/or combine, the art of record to reach the applicants' claims at issue, no *prima facie* case of obviousness has been established. Accordingly, the applicants respectfully request that the Examiner allow claims 1-9 for at least this reason.

The applicants have amended claim 1 solely to clarify that the CPE is configured for two-way communication with the base station to which it is assigned. Although that is inherent in the original claim, it may help clarify that there is no suggestion to combine the references in the manner in which the Examiner has combined them nor do the combined references operate for their intended purpose. specifically, Chambers describes a two-way low-power microcellular system, Schreiber describes a high-power one-way television transmitter network, and Engels describes the design of an integrated circuit modem and does not even mention an antenna, much less an internally deployed antenna. This combination of references do not suggest the network of claim 1, in which a plurality of base stations have a coverage area with a

radius coverage range of one to ten miles, a plurality of CPE assigned to each base station and configured for two-way communication with that base station, and an antenna deployed internally within the premise where the CPE is located. Accordingly, claim 1 is clearly allowable over the cited references. Claims 2-8 are also allowable in view of the fact that they depend from claim 1, further in view of the recitation in each of those claims.

Claim 64 is also directed to a fixed wireless network in which a plurality of base stations communicate on a set of channels in a defined frequency range and have a communication range with a radius between one and ten miles and a receiver to receive communications from locations remote from the base stations. Claim 64 also recites a plurality of CPE assigned to each base station and located at a premise within the corresponding coverage area of that base station with each CPE having a receiver to receive communications from the assigned base station and a transmitter to transmit data to the assigned base station. Finally, claim 64 recites an antenna deployed internally within the premise where the CPE is located. As discussed above with respect to claim 1, the combination of references do not suggest the network in claim 64. Without repeating the arguments in toto, it is clear that the Examiner has not established a *prima facie* case of obviousness in combining these references. Furthermore, as discussed in detail above, the combination of references are unsatisfactory for its intended purpose. Chambers is directed to a low-power microcellular two-way communication system, while Schreiber is directed to a high-power one-way television transmitter having a much greater range. One skilled in the art would not look to combine a system designed for short-range two-way communication with a longer range one-way television transmitter. Furthermore, Engels is disclosed "merely as teaching a non line of sight internally deployed antenna." (See Office Action page 18.) As noted above, Engels does not disclose any antenna, internal or external, and does not even mention the word. The combination of references do not suggest a plurality of base stations having the recited range and operating using OFDM communication or a plurality of CPEs with receivers and transmitters to communicate with the assigned base station and internally deployed antenna, as recited in claim 64. For these reasons, claim 64 is clearly allowable over the cited references.

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,867,485 to Chambers combined with a publication by Engels. The applicants respectfully traverse this rejection and request reconsideration. The applicants have previously discussed the inappropriateness of combination of Chambers, Schreiber, and Engels. The same issues are present in the combination of Chambers and Engels to reject the claims 9-12. Specifically, the Examiner cites Engels "merely as teaching of a non line of sight internally deployed antennas." (See Office Action, page 18.) As discussed above, Engels does not disclose any antenna of any form. Accordingly, it is wholly inappropriate to ascribe any characteristics to an element that is not even mentioned in a reference. The Examiner has not established a *prima facie* case of obviousness; the references do not suggest the combination of references. The Examiner has not considered the claim as a whole, but has impermissibly used hindsight analysis to find references that are used in the Office Action to reject pieces of claims. Finally, even if *arguendo* Engels could be combined with Chambers, the indoor communication system of Engels renders Chambers unsatisfactory for its intended purpose. For these reasons, among others, claims 9-12 are clearly allowable over Chambers and Engels.

Claims 60-63 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Chambers and Schreiber. The applicants respectfully traverse this rejection and request reconsideration. As discussed above, the Examiner has not established a *prima facie* case of obviousness. The combination of Chambers and Schreiber is inappropriate for several reasons. There is no suggestion to combine the references and the Examiner has not provided any objectively verifiable suggestion for the combination. The piecemeal analysis clearly does not consider the claims as a whole. This is an impermissible form of analysis.

Furthermore, as discussed above, the combination of references cannot stand if they render the prior art invention unsatisfactory for its intended purpose. (See M.P.E.P. § 2143.01V.) Adding the high power system of Schreiber to the system of Chambers renders the low power microcellular system of Chambers unsatisfactory for its intended purpose. In accordance with M.P.E.P., there is no suggestion to combine references that make the prior art system unsuitable for its intended purpose.

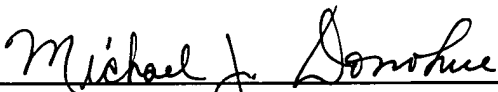
Accordingly, claims 60-63 are clearly allowable over the combination Chambers and Schreiber.

In view of the above amendments and remarks, reconsideration of the subject application and its allowance are kindly requested. The applicants have made a good faith effort to place all claims in condition for allowance. If questions remain regarding the present application, the Examiner is invited to contact the undersigned at (206) 628-7640.

Respectfully submitted,

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